

REMARKS

Applicants have reviewed this Application in light of the Office Action mailed November 17, 2009. Claims 17-22 are pending, and Claims 1-16 were previously cancelled without prejudice or disclaimer. All pending Claims 17-22 were rejected in the Office Action. Claims 17, 18, 21, and 22 are amended herein. Applicants respectfully request reconsideration and allowance of all pending Claims 17-22.

Rejections under 35 U.S.C. § 102

Claims 17 and 22 stand rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,613,213 issued to Marc C. Naddell et al. ("*Naddell*").

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Applicants believe that independent Claims 17 and 22 were previously allowable over *Naddell*, because the Examiner's interpretation of *Naddell* was overly broad. However, in order to advance prosecution, Applicants have further amended independent Claims 17 and 22 to further clarify the distinctions from *Naddell*. For example, amended Claim 17 (emphasis added) recites:

a plurality of service type lists, *each service type list corresponding to a different one of the plurality of different service types and listing only services of one particular service type which are provided by any of said mobile radio networks*, said services stored using said data records, said data records containing information used by said services to be assessed by a user.

Applicants' specification explains (with emphasis added):

[0007] ... regardless of how diverse services presented [by various mobile radio networks or systems] are it will always be possible to **divide these services into different types, with each type having an associated data record which shows the type of the service in a way which the communication terminal is able to evaluate.**

[0008] It is possible for the use of such data records to be standardized across mobile radio standards, so that one and the same data record always specifies the same service type regardless of the respective mobile radio network or system which is being used. ...

[0009] Preferably, the communication terminal is designed such that it respectively stores services of the same type which are repeatedly provided by the mobile radio networks using the data records in the communication terminal in the form of a service type list. In this embodiment, **the data records, which are associated with one respective service type, are used to combine services of the same type within the communication terminal in the form of a list from which it is possible to select. It goes without saying that it is possible to provide a plurality of service types with a corresponding number of lists which are then all stored in the communication terminal.**

Applicants' specification also provides an example situation at paragraphs 0019-0021.

Suppose a first radio network M1 provides three different types of services (S1, S2, S3):

- (1) a sports information service [service M1S1],
- (2) a weather forecasting service [service M1S2], and
- (3) a voice service [service M1S3].

Further suppose a second radio network M2 also provides three different types of services (S1, S2, S3):

- (1) a sports information service [service M2S1],
- (2) a weather forecasting service [service M2S2], and
- (3) a voice service [service M2S3].

According to the claimed invention, a plurality of service type lists are generated and stored, each corresponding to a different one of the three service types and listing only services of one particular service type which are provided by any of said mobile radio networks. Thus, the plurality of service type lists in this example would include three service type lists, each corresponding to a different one of the three service types S1, S2, and S3:

| | <u>List 1</u> | <u>List 2</u> | <u>List 3</u> |
|--------------|---------------|---------------|---------------|
| Service type | S1 | S2 | S3 |
| Services | M1S1 | M1S2 | M1S3 |
| | M2S1 | M2S2 | M2S3 |

As recited in amended Claims 17 and 22, each service type list corresponds to a different one of the three different service types and lists only services of one particular service type which are provided by any of said mobile radio networks. Thus, for example, service type list 1 corresponds to service type 1 and lists only services (M1S1 provided by network M1, and M2S1 provided by network M2) of service type 1 provided by networks M1 and M2. Similarly, service type list 2 corresponds to service type 2 and lists only services (M1S2 provided by network M1, and M2S2 provided by network M2) of service type 2 provided by networks M1 and M2.

Naddell does not teach these limitations. *Naddell* teaches a service table 207, as shown in Figure 2:

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| SERVICE TABLE | |
|---------------|------------|
| SYSTEM | SERVICES |
| A | S1, S2, S3 |
| B | S3, S4 |
| C | ... |
| ... | ... |
| ... | ... |
| ... | ... |
| N | ... |

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As discussed at col. 3, lines 25-40 of *Naddell*, service table 207 includes “a list of systems 208 and a list of services 209.” The list of systems 208 is a list of systems A, B, C, etc. that provide services available to a communications unit. The list of services 209 is a list of services provided by each system A, B, C, etc.

Lists 208 and 209 cannot be equated with the “plurality of service type lists” recited in amended Claims 17 and 22. First, lists 208 and 209 do not each correspond to a different one of a plurality of different service types. Rather, list 208 does not correspond to any particular service type, and list 209 includes *all* service types (S1, S2, S3, S4, ...) provided by any system A, B, C, ... , and therefore also does not list only services of one particular service type (e.g., S1).

Further, even if service table 207 is viewed as defining a plurality of lists, each corresponding to one system A, B, C, ..., such lists cannot be equated with the “plurality of service type lists” recited in amended Claims 17 and 22. These lists are shown below with reference to service table 207 as lists A, B, and C.

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| SYSTEM | SERVICES |
|--------|------------|
| A | S1, S2, S3 |
| B | S3, S4 |
| C | ... |
| ... | ... |
| ... | ... |
| ... | ... |
| N | ... |

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List A
List B
List C

Lists A, B, and C cannot be equated with the “plurality of service type lists” recited in amended Claims 17 and 22. First, each of lists A, B, and C does not correspond to a *different one* of a plurality of different service types S1, S2, S3, S4, For example, list A corresponds to three service types S1, S2, S3, while list B corresponds to two service types S3, S4. Further, each of lists A, B, and C does not *list only services of one particular service type*. For example, list A lists services of three different service types S1, S2, and S3, and list B lists services of two different service types S3 and S4.

Therefore, no matter how the “lists” of service table 207 are defined (i.e., lists 208 and 209, or lists A, B, C, ...), service table 207 does not include “a plurality of service type lists, *each service type list corresponding to a different one of the plurality of different service types and listing only services of one particular service type which are provided by any of said mobile radio networks,*” as recited in amended Claims 17 and 22.

For at least these reasons, Applicants respectfully request reconsideration and allowance of amended Claims 17 and 22, as well as claims 18-21 that depend from Claim 17.

Rejections under 35 U.S.C. § 103

Dependent Claims 18-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Naddell* in view of U.S. Patent No. 5,903,832 issued to Jorma Seppanen et al. ("*Seppanen*").

Applicants respectfully submit that dependent Claims 18-21 are allowable at least because they depend from independent Claim 17, shown above to be allowable. Further, *Seppanen* does not teach the limitations not taught by *Naddell*, discussed above. For at least these reasons, Applicants respectfully request allowance of dependent Claims 18-21.

CONCLUSION

Applicants have now made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants believe no fees are due; however, should the Commissioner deem that any additional fees are due, including any fees for any additional extensions of time, the Commissioner is hereby authorized to debit said fees from deposit account number 50-4871.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.457.2030.

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2/25/10

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